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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,287	05/30/2000	Yuhpyng L. Chen	U-014295-9	1655
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Ladas & Parry		JONES, DWAYNE C		
26 West 61st Street		ART UNIT		
New York, NY 10023		PAPER NUMBER		
		1614		

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/580,287	<b>Applicant(s)</b> CHEN, YUHPYNG L.	
	<b>Examiner</b> Dwayne C Jones	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08DEC2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 29-47 is/are pending in the application.  
4a) Of the above claim(s) 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-15 and 29-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16-28 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/8/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-15 and 29-45 are pending.
2. Claims 1-15, and 30-45 are rejected.

### ***Response to Arguments***

3. Applicant's arguments and declaration filed December 8, 2003 have been fully considered but they are not persuasive. Applicant presented the following allegations. First, applicants argue that there is written description for the treatment of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions and claim 14 is also direct a laundry list of disorders or conditions that are not adequately described in the instant specification. Second, applicant alleges that the WO 94/13676 because (a) this reference is less than one year from the priority date of the instant application and (b) the inventive entity under 102(a) is not the same. Third, applicant argues that DE 3,145,287 teaches of different compound than those that are instantly claimed.

4. First, applicants argue that there is written description for the treatment of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions and claim 14 is also direct a laundry list of disorders or conditions that are not adequately described in the instant specification. It is agreed with applicants that there is support for the binding of the instantly claimed antagonists to CRF with the binding affinities to the CRF in both the instant specification

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as well as the Declaration of December 8, 2003. However, it is noted that there is no adequate written description that by binding to the receptor site of CRF that there is any linkage or correlation with the actual treatment of a sundry laundry list of disorders or conditions and claim 14.

5. Second, applicant alleges that argues that DE 3,145,287 teaches of different compound than those that are instantly claimed. One having ordinary skill in the art would have been motivated to select the claimed compound with the expectation that substitution of a double bond for a single bond that is apart of pyrrolidinyl ring would not significantly alter the analogous properties of the compound of the reference due to the close structural similarity of the compounds. The skilled artisan would have been motivated to use the closely related compounds of DE 3,145,287 because although there is the issue of aromaticity in the prior art compound, the close structural relationship to the claimed compounds would be rendered obvious. It is well within the level of the skilled artisan to selectively block or protect unwanted positions from a reaction, thereby allowing the desired portions of the compounds, such as that of a 5-membered pyridinyl-fused ring structure.

#### ***Election/Restrictions***

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance

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with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

7. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

8. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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9. In addition, the following advisory is mentioned. Once product claim 1 is found to be allowable, withdrawn and cancelled claims 16-28 are to be rejoined, pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86). Claims 16-28, directed to the process of using the patentable product as well as pharmaceuticals thereof, previously withdrawn from consideration as a result of a restriction requirement of September 27, 2001. In addition, it is further noted that In accordance with the Official Gazette notice, *supra*, process claims 16-28, must include all the limitations of the allowable product in order to be rejoined. Accordingly, it is recommended that these non-elected claims are to be limited in scope with the instant compounds claims as well as definiteness, under 35 U.S.C. 112, second paragraph.

#### ***Information Disclosure Statement***

10. The information disclosure statements filed on December 8, 2003 have been reviewed and considered, see enclosed copies of PTO FORMs 1449.

#### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. The rejection of claims 14, 15, and 30-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as

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to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is maintained and repeated. In particular, claim 13 is directed to a pharmaceutical composition for the treatment of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions and claim 14 is also directed to a laundry list of disorders or conditions that are not adequately described in the instant specification. There is insufficient descriptive support for the functional term of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions. Moreover, the specification does not adequately describe what is meant by the functional characteristics of the of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions. The specification only has described the binding activities for compounds I, II and III as they are possessing CRF antagonist activity. There is no description of an actual reduction to practice, each step of the claimed pharmaceutical method with its intended use in order to show that the applicant was in possession of the claimed invention. Therefore, the claim fails to comply with the written description requirement.

13. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089, 118 S.Ct. 1548 (1980), holds that an adequate written description requires a precise definition, such as by structure, formula, chemical name, or physical properties, "not a mere wish or plan for obtaining the claimed chemical invention." *Eli Lilly*, 119 F.3d at 1566. The Federal Circuit has

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adopted the standard set forth in the Patent and Trademark Office ("PTO") Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, 1 "Written Description" Requirement ("Guidelines"), 66 Fed. Reg. 1099 (Jan. 5, 2001), which state that the written description requirement can be met by "showing that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics, "including, inter alia, "functional characteristics when coupled with a known or disclosed correlation between function and structure...." Enzo Biochem, Inc. v. Gen-Probe., 296 F.3d 316, 1324-25 (Fed. Cir. 2002) (quoting Guidelines, 66 Fed. Reg. At 1106 (emphasis added)). Moreover, although Eli Lilly and Enzo were decided within the factual context of DNA sequences, this does not preclude extending the reasoning of those cases to chemical structures in general. Univ. of Rochester v. G.D. Searle & Co., 249 F. Supp.2d 216, 225 (W.D.N.Y 2003).

14. Claims 14, 15, and 30-45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the binding activities to the CRF receptor, does not reasonably provide enablement for the treatment of disorder or condition of which can be effected or facilitated by antagonizing CRF as well as laundry list of disorders or conditions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in In re



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Wands, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

(1) The nature of the invention:

The instant invention is directed to the functional recitation of the treatment of disorder or condition of which can be effected or facilitated by antagonizing CRF as well as laundry list of disorders or conditions. The method comprises administering the compounds of claim 1.

(2) The state of the prior art

The compounds of the inventions are heterocyclic compounds of claim 1. However, the prior art does not teach that these all of these purported ailments and conditions are treated by the administration of these compounds. In fact, U.S. Patent No. 4,605,642 only states that antagonists of CRF "may be" or "should" useful in a variety of ailments or conditions.

(3) The relative skill of those in the art

The relative skill of those in the art of pharmaceuticals is high.

(4) The predictability or unpredictability of the art

The unpredictability of the pharmaceutical art is very high. In fact, the courts have made a distinction between mechanical elements functioning the same in different circumstances, yielding predictable results, but chemical and biological compounds often react unpredictably under different circumstances. Nationwide Chem. Corp. v. Wright, 458 F. Supp. 828, 839, 192 USPQ 95, 105(M.D. Fla. 1976); Aff'd 584 F.2d 714, 200 USPQ 257 (5<sup>th</sup> Cir. 1978); In re Fischer, 427 F.2d 833, 839, 166 USPQ 10, 24 (CCPA 1970). Thus, the physiological activity of a chemical or biological compound is considered to be an unpredictable art. For example, in Ex Parte Sudilovsky, the Court held that Appellant's invention directed to a method for preventing or treating a disease known as tardive dyskinesia using an angiotensin converting enzyme inhibitor involved unpredictable art because it concerned the pharmaceutical activity of the compound. 21 USPQ2d 1702, 1704-5 (BDAI 1991); In re Fisher, 427 F.2d 1557, 1562, 29 USPQ, 22 (holding that the physiological activity of compositions of adrenocorticotrophic hormones was unpredictable art; In re Wright, 999 F.2d 1557, 1562, 29 USPQ d, 1570, 1513-14 (Fed. Cir. 1993) (holding that the physiological activity of RNA viruses was unpredictable art); Ex Parte Hitzeman, 9 USPQ2d 1821, 1823 (BDAI 1987); Ex Parte Singh, 17 USPQ2d 1714, 1715, 1716 (BPAI 1990). Likewise, the physiological or pharmaceutical activity of the claimed compounds of claims 14 and 15 prior to filing of the instant invention was an unpredictable art.

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## (5) The breadth of the claims

The instant claims are very broad. For instance, claims 14 and 15 are directed to the plethora of compounds or formulas of the treatment of disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions. The breadth of claims was a factor in Amgen v. Chugai Pharm. Co., 927 F.2d 1200, 18 USPQ2d (Fed. Cir.), cert. Denied, 502 U.S. 856 (1991). In the Amgen case, the patent claims were directed to DNA sequences that encoded amino acid sequences. Because a very small change in the amino acid sequence of a protein can result in a very large change in the structure-function activity of a protein and because the laws of protein folding are in such a primitive state, predicting protein structure (and hence, activity) while knowing only the sequence of the protein is akin to predicting the weather for a date in the future.

## (6) The amount of direction or guidance presented

The amount of guidance or direction needed to enable the invention is inversely related to the degree of predictability in the art. In re Fisher, 839, 166 USPQ 24. Thus, although a single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements, in cases involving unpredictable factors, such as most chemical reactions and physiological activity, more teaching or guidance is required. In re Fischer, 427 F.2d 839, 166 USPQ 24; Ex Parte Hitzeman, 9 USPQ 2d 1823. For example, the Federal Circuit determined that, given the unpredictability of the physiological activity of RNA viruses, a specification requires

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more than a general description and a single embodiment to provide an enabling disclosure for a method of protecting an organism against RNA viruses. In re Wright, 999 F.2d 1562-63, 27 USPQ2d 1575. In the instant case, given the unpredictability of the physiological or pharmaceutical activity of the compounds of claim 1 to be effective in functionally treating of the treatment of disorder or condition of which can be effected or facilitated by antagonizing CRF as well as laundry list of disorders or conditions {list ailment} is insufficient for enablement. The specification provides no guidance, in the way of enablement for the compounds claim 1 other than the binding activities to CRF. In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (contrasting mechanical and electrical elements with chemical reactions and physiological activity). See also In re Wright, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This is because it is not obvious from the disclosure of one species, what other species will work. In re Dreshfield, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases," 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail. A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds that fall within the scope of a claim will possess the alleged activity. See In

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re Riat et al. (CCPA 1964) 327 F2d 685, 140 USPQ 471; In re Barr et al. (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

(7) The presence or absence of working examples

As stated above, the specification discloses the compounds of claim 1 that have of the treatment of disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions. However, the instant specification only has enablement for binding ability to CRF. There are no examples of showing an actual reduction or treatment of the claimed diseases or conditions in the instant specification.

(8) The quantity of experimentation necessary

The quantity of experimentation needed to be performed by one skilled in the art is yet another factor involved in determining whether "undue experimentation" is required to make and use the instant invention. "The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed." In re Wands, 858 F.2d 737, 8 USPQ2d 1404 (citing In re Angstadt, 537 F.2d 489, 502-04, 190 USPQ 214, 218 (CCPA 1976)). For these reasons, one of ordinary skill in the art would be burdened with undue "painstaking experimentation study" to determine all of the disorders or

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conditions of which can be effected or facilitated by antagonizing CRF as well as laundry list of disorders or conditions that would be enabled in this specification.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claim 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following explanations support this?? rejections. First, under the variable section of  $R_1$ , the group “-CONC<sub>1</sub>-C<sub>4</sub>hydrocarbyl)(C<sub>1</sub>-C<sub>2</sub>hydrocarbyl) has a missing parenthesis. Second, under the section that states that “ $R_1$  and  $R_2$  of B may form a saturated 5- to 8-membered ring which may optionally contain one or two double bonds,” confusion arises with this phrase because a saturated ring cannot contain any multiple bonds. Third, under the variable of  $R_5$ , there is no comma in between “cyano - $NR_{24}R_{25}$ ”, which suggests that this could be  $NCNR_{24}R_{25}$  and thus render the claim ambiguous. Fourth, under the section defining the variables of  $R_{24}$  and  $R_{25}$ , the phrase, “C<sub>1</sub>-C<sub>4</sub>alkyl, and can optionally contain one or two double or triple bonds” makes the claim unclear. More specifically, this phrase can suggest that the C<sub>1</sub>-C<sub>4</sub> alkyl moiety may possess unsaturation, in which case, the claim is rendered vague and indefinite.

17. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Under the variable section of  $R_2$  there should be a space

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between "C<sub>1</sub>-C<sub>12</sub>hydrocarbyl" and the word "and" in the term, "C<sub>1</sub>-C<sub>12</sub>hydrocarbyland."

In the R<sub>7</sub> section, the group "-CH<sub>2</sub>OCH<sub>2</sub>CH<sub>3</sub>" needs a subscript for the number "3."

18. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. When B is defined as "-NR<sub>1</sub>R<sub>2</sub>", the variable of R in this group is not specified, thus generating confusion to the claim.

19. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by the group "CH<sub>2</sub>Cl" because the valency of carbon is not met for this moiety.

20. Claims 11 and 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Confusion arises with the phrase, "which may optionally contain one carbon-carbon double or triple bond" because this refers to the saturated C<sub>1</sub>-C<sub>6</sub> alkyl moiety.

21. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is drawn to treating a mood disorder selected from a group consisting of inflammatory disorders, rather than mood disorders. It is unclear why inflammatory disorders are collectively referred to as mood disorders.

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***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. The rejection of claims 1-15 and 29-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3,145,287. DE 3,145,287 teaches of the pyrrolopyrimidine compounds as depicted by formula (I), (see abstract and claims 1-10). These compounds have an identical core structure and identical substituents on the core ring structure. The claims differ from the prior art by having a double bond in lieu of a single bond of a pyrrolidinyl ring moiety of the prior art. One having ordinary skill in the art would have been motivated to select the claimed compound with the expectation that substitution of a double bond for a single bond that is apart of pyrrolidinyl ring would not significantly alter the analogous properties of the compound of the reference due to the close structural similarity of the compounds. The skilled artisan would have been



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motivated to use the closely related compounds of DE 3,145,287 because although there is the issue of aromaticity in the prior art compound, the close structural relationship to the claimed compounds would be rendered obvious. It is well within the level of the skilled artisan to selectively block or protect unwanted positions from a reaction, thereby allowing the desired portions of the compounds, such as that of a 5-membered pyridinyl-fused ring structure.

### ***Obviousness-type Double Patenting***

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 1-15 and 29-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 09/761,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of these applications teach of bicyclic CRF antagonists, (see formula II of copending Application No. 09/761,611).

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27. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

28. Claims 1-15 and 29-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/160,206. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of these applications teach of bicyclic CRF antagonists, (see claim 1 of copending Application No. 10/160,206).

29. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

30.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Thursday, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, may be reached at (571) 272-0584. The official fax No. for correspondence is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

  
**DWAYNE JONES**  
**PRIMARY EXAMINER**

Tech. Ctr. 1614  
April 5, 2004